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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/535,685	05/19/2005	Georg Rudiger Kotzian	70176	7932

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EXAMINER

SULLIVAN, DANIELLE D

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

09/23/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/535,685

**Applicant(s)**

KOTZIAN, GEORG RUDIGER

**Examiner**

DANIELLE SULLIVAN

**Art Unit**

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3 and 4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3 and 4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

Claims 1, 3 and 4 are pending. Claim 2 has been cancelled.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. (WO 00/05956) in view of Davies et al. (Review Herbicide Safeners a review, 1999).

### **Applicant's Invention**

Applicant claims a composition comprising a mixture of metamifop and a synergistically effective amount of S-metolachlor.

### **Determination of the scope and the content of the prior art**

#### **(MPEP 2141.01)**

Kim et al. teaches the compound metamifop (component (a)) (formula (1), wherein  $R=CH_3$ ,  $X=H$  and  $Y=H$  (Table 1, first listing, page 5). The herbicide can be used alone or in combination with other herbicides, insecticides or bactericides (page 21, lines 18-20). Kim et al. teaches that it is used on maize (page 24, Table 5; page 25, Table 6).

### **Ascertainment of the difference between the prior art and the claims**

**(MPEP 2141.02)**

Kim et al. does not teach S-metolachlor. It is for this reason that Davies et al. is joined. Davies et al. teaches metolachlor as an herbicide used to treat maize (page 1047, Table 2).

**Finding of prima facie obviousness**

**Rationale and Motivation (MPEP 2142-2143)**

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kim et al. and Davies et al. to further include the combination of metamifop and S-metolachlor. It would be prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose in view of In re Kerkhoven 205 USPQ 1069 (C.C.P.A 1980).

Claim 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. (WO 00/05956) in view of Hudetz et al. (US 5,981,432).

**Applicant's Invention**

Applicant claims a method of controlling undesired plant growth in crops of useful plants, comprising the application of a herbicidally effective amount of a composition to a crop plant or locus thereof, wherein the composition includes metamifop and a synergistically effective amount of S-metolachlor. Preferably, the crop plant is rice.

**Determination of the scope and the content of the prior art**

**(MPEP 2141.01)**

Kim et al. discloses a method of using the compound metamifop, in combination with other herbicides, to control barnyard grass produced from rice and maize (page 1, lines 6-19; page 24, Table 5; page 25, Table 6).

**Ascertainment of the difference between the prior art and the claims**

**(MPEP 2141.02)**

Kim et al. does not teach the combination of metamifop with S-metolachlor in a method for controlling undesired plant growth. It is for this reason that Hudetz et al. is joined.

Hudetz et al. teaches herbicidal compositions comprising S-metolachlor suitable for selectively controlling weeds in crops of useful plants, including rice (column 1, lines 8-17).

**Finding of prima facie obviousness**

**Rationale and Motivation (MPEP 2142-2143)**

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kim et al. and Hudetz et al. to further include a method of using metamifop in combination with S-metolachlor to treat undesired plant growth on rice. One would have been motivated to combine two compositions with herbicidal activity into one method since they are both known to be used to protect rice from undesired plant growth in order with a reasonable expectation of success.

***Response to Arguments***

Applicant's arguments filed 06/16/2008 have been fully considered but they are not persuasive.

Applicant argues that the rejection under 103 with reference to being unpatentable over Kim et al. in view of Davies et al. lacks and articulated reasoning underpinning to support the rejection. The Examiner has provide reference to the fact that both metamifop and metolachlor are known herbicides used on maize. Applicants further argue that synergistic effect is not taught.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the specific amounts necessary for the synergistically effective amount of S-metolachlor) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, the synergistic effect as claimed does not add any patentable weight to the invention. And the composition is prima facie obvious.

Applicant argues that Kim et al. teaches away from S-metolachlor because it lists metamifop is used only with certain herbicides. The Examiner disagrees with this argument. Kim et al. states the metamifop may be used alone or in combination with other herbicides. The essential agents listed thereafter do not further limit the scope of their invention to only containing those ingredients. The fact that the present claims recite comprising language shows that these essential ingredients could still be included

in the composition of the present invention along with other herbicides including s-metolachlor.

Furthermore, it should be noted that metamifop and metolachlor are anilide herbicides and therefore manifest a similarity in core structure, namely an anilide core. Therefore, one of ordinary skill in the art would have been motivated to combine the compounds into a single composition because they would manifest similar properties due to similar structure. The fact that Hudetz et al. and Kim et al. teach that s-metolachlor and metamifop, respectively, are useful in controlling weeds in maize and rice provides evidence of this fact.

No claims are allowed at this time.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIELLE SULLIVAN whose telephone number is (571)270-3285. The examiner can normally be reached on 7:30 AM - 5:00 PM Mon-Thur EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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